UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/070,908	05/04/1998	MITSUNORI SAKAMA	0756-1799	4942

31780 7590 03/09/2004

ERIC ROBINSON
PMB 955
21010 SOUTHBANK ST.
POTOMAC FALLS, VA 20165

EXAMINER	
PADGETT, MARIANNE L	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
Supplement to paper #37	09/070,908	SAKAMA, MITSUNORI	
	Examiner	Art Unit	
	Marianne L. Padgett	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/29/03 noting error in rejected claim#*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-29,31-50 and 58-129* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-29, 31-50 & 58-129* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. This action is being reopened to formally correct the errors in the claim numbers listed in the rejection and is supplementary to the final rejection, which will be resummarized below to include claims 105, 111 and 112, which while listed as rejected, and referred back to as rejected in section 3 of paper # 30 mailed 3/31/02 or section 5 of paper # 37, mailed 11/27/02. Were not formally listed in the referenced rejection, as noted by applicant on page 3 of their brief. It is noted that claim 105 is the same as claims 104, 106, 109 and 110, except for dependence on independent claim 24, and that all those claims plus claims 23-29 from which they depend were previously rejected, so that the subject matter has been covered, and omission unintended as evidence by latter reference of claim 105 in the subsequent rejection, as previously rejected.

Analogously, claim 111 is the same as claim 107-108, 113 and 115, accept for its dependence from independent claims 58, instead of 26, 27, 70 or 82 respectively, and all of these claims including 58 were rejected in section 2 paper # 30, with section 3 indicating that 111 had also been included therein.

Similarly, claim 112, is the same as 114 or 116, except for dependence on claim 64, instead of 76 or 87, where again the rejection of all is identical to that of claims 105 or 111 and their analogues. These corrections were obvious in view of prior rejection as stated above and create no new issues in the rejection, so the action may properly be made final.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 23-29, 45-50 and 58-129 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-63, or claims 1-5, 12-21 and 27-30 of U.S. Patent No. 6,281,147, or U.S. Patent No. 6,015,762, respectively in view of Gupta et al (6,289,834), optionally considering Kozuka (5,420,044), as applied in section 3, paper# 33, mailed 4/16/02.

4. Claims 23-29, 45-50, 58-59, 61-65, 67-82, 84-87 and 89-129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuka in view of Gupta et al (6,289,843B1 and 5,456,796) as applied in paper# 30 (mailed 3/3/02), section 2.

5. Claims 60, 66, 83 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuka, in view of Gupta et al (843B1 and 796) alone as applied above in claims 23-29, 45-50, 58-59, 61-65, 67-82, 84-87 and 89-129, **or** further in view of Mei et al (5,366,926), or Kaschmitter et al (5,346,850), or Yamazaki et al (5,313,076) applied in paper# 30, section 2, mailed 3/31/02.

6. Claims 31-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuka, in view of Gupta et al (796 & 843B1) as applied to claims 23-29, 45-50 and 58-129 above, and further in view of Mei et al, or Kaschmitter et al, or Yamazaki et al (076), as applied in section 3 (page 8-9) of paper# 30.

7. An update provide art of interest to the important maintaining pressure or obtaining a steady state flow rate for plasma processes in Rossman et al or Tanabe et al (col. 5) or Raaijmaker et al [0120].

8. It is further noted that discussion of arguments in section 6 of paper# 37 (mailed 11/27/02), and in the advisory action, paper# 39, mailed 5/21/03, remain relevant. Despite applicants' comments about allowability of claims 105, 111 & 112 at the end of their Brief, their indication of all claims standing or falling together, indicate that they do not think the subject matter of these dependent claims (flow rate of 100 sccm) is a patentably distinction.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication should be directed to Marianne L. Padgett at telephone number (571) 272-1425 on M-F from about 8:30 am - 4:30 pm, & FAX#(703) 872-9306 (all official).

M. L. Padgett/af

February 26, 2004

March 2, 2004

MARIANNE PADGETT
PRIMARY EXAMINER